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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,938	01/18/2002	Gareth Williams	H8610/259296	7839

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EXAMINER
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PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

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DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/856,938**

Applicant(s)  
**Williams et al**

Examiner  
**Alton Pryor**

Art Unit  
**1616**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 23, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6,8 6) ☐ Other:

### ***Election Requirement***

Election requirement is final. Applicant elected the invention of Example 2 comprising Bethoxazin, Cyproconazole, methy diethoxol, dowanol PnB, mineral oil, plus tridecanol 10 EO with traverse. Applicant argues that Examiner is forcing Applicant into what amounts to "consisting essentially of" terminology without the citation of any prior art. Applicant further argues that this is the type of rejection using 35 U.S.C. 121 that was forbidden.

Examiner points out that no rejection has been made and that the Examiner has only requested the election of a single disclosed composition to initiate the examination process. Examiner would also like to point out that such a request does not force Applicant into "consisting essentially of" claims. Examiner would like to reiterate that an Election of invention by Applicant initiates the examination process and does not limit the scope of Applicant's claims.

The elected composition / method of Example 2 comprising Bethoxazin, Cyproconazole, methyl diethoxol, dowanol PnB, mineral oil, tridecanol 10EO is allowable.

### ***Claim Rejection under 35 U.S.C. 112, 2nd paragraph***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7, 9, 12, 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 7 recites the limitation "Cyproconazole" in line 4. There is insufficient antecedent basis for this limitation in the claim.

4. The term "other material" in claims 9, 12 is a relative term which renders the claim

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indefinite. The term "other material" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What is the "other material"?

Claim 13 provides for the use of the fungicide, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Objection under 37 CF R 1.75 (c)***

Claim 9-12 are objected to under 37 CF R 1.75© as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and/or cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

***Claim Rejection under 35 U.S.C. 103(a)***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5,7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (US 5777110; 7/7/98) and Rustenburg et al (US 6423732; 7/23/02). Davis teaches a method of protecting wood against wood destroying materials (fungi) comprising applying to the wood a composition comprising 3-(benzo[b]thien-2-yl)-5,6-dihydro-1,4,2-oxathiazine 4-oxide plus additional actives. See abstract, column 1 line 55 - column 3 line 41, column 8 Example 9. The additional actives include Cyproconazole which is a fungicide known to function as a wood preservative. See column 5 lines 54 - 60. Davis does not teach the instant composition / method comprising a quaternary ammonium compound. However, Rustenburg teaches a method of protecting wood against wood destroying fungi such as Ascomycetes and Deuteromycetes comprising applying to the wood a composition comprising Cyproconazole plus dimethyldidecylammonium chloride (quaternary ammonium salt). See abstract, column 1 line 38 - column 2 line 21, column 3 lines 5-25. It would have been obvious to one having ordinary skill in the art to combine the prior art inventions to arrive at a single method of protecting wood against wood destroying fungi comprising applying to the wood a composition comprising 3-(benzo[b]thien-2-yl)-5,6-dihydro-1,4,2-oxathiazine, Cyproconazole, plus dimethyldidecylammonium chloride. One would have been motivated to do this in order to enhance the effectiveness of the method of protecting wood against wood destroying fungi.

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***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Alton Pryor

**ALTON N. PRYOR**  
**PRIMARY EXAMINER**  
Primary Examiner, AU 1616

7/2/03